



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT and the documents referred to as enclosed therein are being deposited with the United States Postal Service on the date indicated below with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Thomas Fitting
Thomas Fitting, Reg. No. 34,163

July 21, 2000
Date of Deposit

Applicant: Brooks, et al.)
Serial No.: 09/081,522) Group Art Unit: 1644
Filed: May 19, 1998) Examiner: P. Gambel
Title: METHODS AND COMPOSITIONS)
USEFUL FOR INHIBITION OF)
ANGIOGENESIS) Our Ref.: TSRI 419.0C1
)

#11 8/2/00
TGray

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This communication is in response to the Restriction Requirement mailed March 22, 2000, (Paper No. 7). Enclosed herewith is a petition requesting a three-month extension of time for response to the Requirement, making this a timely response.

The present Restriction Requirement is unusual because it does not contain an identification of different groups to choose between. Thus, it appears that all pending claims 17-150 comprise a single group for purposes of examination, in which two different types of allegedly distinct species are identified in Paragraphs 4 and 5. Thus there is no formal election of a Group required, but rather an election of species "if no generic claim is finally held to be allowable". However, the options for

election of species are confusing, and therefore clarification is respectfully requested.

Paragraph 4

The Action states in Paragraph 4 that there are three "patentably distinct species of claimed Invention", namely "wherein the specificity of inhibiting tissue growth or inflamed tissue or reducing blood supply is a) cancer, b) arthritis, or c) diabetic retinopathy." This characterization is respectfully traversed because it is incomplete in its recitation of claim elements, and therefore Paragraph 4 is misleading. For example, "inducing solid tumor tissue regression" (claim 43), "inhibiting angiogenesis in a carcinoma" (claim 85) and "treating a patient in which neovascularization is occurring in retinal tissue" (claim 125) are three additional inventions not recited by the Examiner. Thus, Applicants respectfully request clarification of the Patent Office's position in the description and identification of "patentably distinct species" under Paragraph 4.

Furthermore, the Action states that "claims 17, 105 and 144 are generic". This characterization is also respectfully traversed. It is submitted that at least claims 43 and 125 should also be considered generic because "inducing regression" (claim 43) is different from "inhibiting growth" (claim 17) and because claim 125 describes neovascularization of a retinal tissue which is a condition distinct from cancer.

In the interest of speeding prosecution, Applicants can at least partially reply, notwithstanding the Action's characterizations and Applicants' traversal and request for clarification. Therefore, under Paragraph 4, Applicants elect the

species associated with inhibiting cancer, if no generic claim is finally held to be allowable. In that regard, Applicants note that independent claims "readable thereon" the elected species are broader in scope than the elected species.

The Action further requests that Applicants provide the methods claims that read on the elected species. It is submitted that the following claims are method claims which read on the elected species under Paragraph 4: claims 17-23, 28-104, 144-150 and 155-170. The identification of these claims is justified at least because claim 17 reads on "a solid tumor tissue (claim 19), claim 64 reads on "a solid tumor tissue" (claim 66), claim 144 reads on " a solid tumor tissue" (claim 146).

Paragraph 5

The Action similarly states in Paragraph 5 that there are two "patentably distinct species of claimed Invention", namely a) antibody or b) polypeptide.

Under Paragraph 5, Applicants elect the species wherein the antagonist is an antibody, if no generic claim is finally held to be allowable. However, it is submitted that Applicants' claims reciting a generic "antagonist" as defined in the claims should be allowed due to the support in the specification for an antagonist.

The Action does not request that Applicants identify those claims which read on the species elected solely under Paragraph 5. However, for clarity in comparing the independent elections under Paragraphs 4 and 5, Applicants will identify those claims, and submit that the following claims read on the elected species under

Paragraph 5: claims 17-38, 43-59, 64-80, 85-100, 105-120, 125-139, 144-165 and 170.

Paragraph 6

Following the request of Paragraph 6, which appears to require that the two elections under Paragraphs 4 and 5 be combined, the combined identification of elected species, subject to the foregoing traversal, is to method claims which read on the use of antibody-type antagonists (Paragraph 5) for treating cancer (Paragraph 4), if no generic claim is finally held to be allowable. Therefore, Applicants submit that the following claims read on the elected species under Paragraph 6 (i.e., by combining the elections under Paragraphs 4 and 5 to find the commonly elected claims): claims 17-23, 28-38, 43-59, 64-80, 85-100, 144-150, 155-165 and 170.

Respectfully submitted,

7/22/2000

Date

Thomas Fitting

Thomas Fitting, Reg. No. 34,163

THE SCRIPPS RESEARCH INSTITUTE
Office of Patent Counsel
10550 North Torrey Pines Road
Mail Drop TPC-8
La Jolla, California 92037
(858) 784-2937

Attorney or agent of record
 Filed Under §1.34(a)